

REMARKS

Applicant acknowledges receipt of an Office Action dated June 15, 2006.

In this response, Applicant has amended the specification to insert an additional paragraph. Support for the amendment to the specification may be found in JP 2002-196215 which was expressly incorporated by reference into the present specification in the last full paragraph on page 14.

In addition, Applicant has cancelled claim 1 without prejudice or disclaimer, amended claim 2, and added claims 11-21. Support for these amendments may be found in the specification, *inter alia*, in the paragraph added to the specification above, in the discussion on page 1 of the specification, the first full paragraph on page 2 of the specification, and the discussion on pages 13 and 14 of the specification. Following entry of these amendments, claims 2-21 are pending in the application.

Reconsideration of the present application is respectfully requested in view of the foregoing amendments and the remarks which follow.

Statement of Substance of Interview

During a personal interview conducted on November 1, 2006, Mr. Paul D. Strain, Mr. Shuji Eguchi, and Examiner Robert Hodge discussed the outstanding rejections under §102 and §103.

Rejections Under 35 U.S.C. § 102

On page 2 of the Office Action, the PTO has rejected claims 1 and 6 under 35 U.S.C. § 102(b) as allegedly being anticipated by EP 1160895 to Hanafusa. In this response, Applicant has cancelled claim 1 without prejudice or disclaimer and has amended claim 6 so that it now depends from claim 2. Accordingly, Applicant submits that the outstanding rejection under §102 is now moot.

Rejections Under 35 U.S.C. § 103

In the Office Action, the PTO has set forth a number of rejections under 35 U.S.C. § 103 which Applicant summarizes below:

- On page 3, the PTO has rejected claims 2-4, 9, and 10 as being unpatentable over Hanafusa in view of JP 2001-256934 to Osaka, JP 2001-114157 to Takahashi and U.S. Patent 5,879,831 to Ovshinsky.
- On page 4, claim 5 as being unpatentable over Hanafusa in view of Osaka, Takahashi, and Ovshinsky, as applied to claims 2-4, 9, and 10, and further in view of U.S. Patent 6,821,671 to Hinton.
- On page 4, claim 7 as being unpatentable over Hanafusa in view of Osaka, Takahashi, and Ovshinsky, as applied to claims 2-4, 9, an 10, and further in view of U.S. Patent 5,688,615 to Mrotek.
- On page 5, claim 8 as being unpatentable over Hanafusa in view of Osaka, Takahashi, and Ovshinsky as applied to claims 2-4, 9, and 10, and further in view of U.S. Patent 6,517,966 to Marukawa.

In this response, Applicant has amended claim 2 to recite a “module battery which serves as a driving source for a vehicle.” In view of this amendment, Applicant respectfully traverses these rejections for the reasons set forth below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See MPEP §2143.

Applicant notes the MPEP §2143.01(V) is titled “A PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE.”

Here, Applicant wishes to direct the PTO’s attention to the fact that independent claim 2 is directed to a “module battery which serves as a driving source for a vehicle.” In contrast, Hanafusa, the primary reference relied upon in each of the rejections under §103, describes a battery for a portable telephone or a notebook PC (see col. 1). Applicant submits that any modification required to make the battery pack disclosed in Hanafusa suitable for use as a driving source for a vehicle would render Hanafusa unsuitable for use as a battery for a

portable telephone or notebook PC. Applicant notes that none of the secondary references can cure this fundamental deficiency. Accordingly, Applicant submits that the outstanding rejections under §103 which are based upon Hanafusa cannot properly be applied to amended claim 2 or any of the claims depending therefrom.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections under §103.

Newly Added Claims 11-21

In this response, Applicant has added claims 11-21. As noted above, support for these new claims may be found in the specification, *inter alia*, in the paragraph added to the specification above, in the discussion on page 1 of the specification, the first full paragraph on page 2 of the specification, the third full paragraph on page 9, and the discussion on pages 13 and 14 of the specification.

With regard to new independent claim 13 and the claims depending therefrom, Applicant notes that none of the cited references, taken either individually or in combination, teach or suggest the combination of “a plurality of battery packs” and “a packing case. . . with an opening for each of the extrude tabs to extend out from the packing cases and connect to each other, wherein each of the openings is arranged linearly” as recited in claim 13.

With regard to new independent claims 17 and the claims depending therefrom, Applicant notes that none of the cited references, taken either individually or in combination, teach or suggest “a battery pack holder for holding the stacked battery packs together so that spaces are provided between adjacent stacked battery packs” as recited in claim 17.

With regard to new dependent claims 11, 12, 14-16 and 18-21, Applicant submits that the rejections based upon Hanafusa do not apply because Hanafusa is directed to a battery for a portable telephone or a notebook PC, and the modifications that would be necessary to arrive at claims 11, 12, 14-16 and 18-21 would render Hanafusa unsuitable for its intended purpose. Furthermore, no combination of Hanafusa with any of the secondary references can resolve this deficiency.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that all of the pending claims are now in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, the Examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

Date November 15, 2006
FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5540
Facsimile: (202) 672-5399

By 
Richard L. Schwaab
Attorney for Applicant
Registration No. 25,479

Paul D. Strain
Attorney for Applicant
Registration No. 47,369

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.